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10/583,373	06/19/2006	Christophe Martin	1032326-000395	2671
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EXAMINER BALAOING, ARIEL A				
ART UNIT 2617		PAPER NUMBER		
NOTIFICATION DATE 05/15/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary

Application No.

10/583,373

Applicant(s)

MARTIN ET AL.

Examiner

ARIEL BALAOING

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 6, 9, 10 are rejected under 35 U.S.C. 102(e) as being anticipated by SCHRIRE et al (US 2004/0235523).

Regarding claim 1, SCHRIRE discloses a method of backing up the personal data of a subscriber of a wireless communication network, the data being memorized in a mobile communication station [1a-1c] and backed up to a network server 3, across a first communication channel and according to a first backup mode (abstract), comprising

the following steps: determining whether the mobile device has a function that allows it to establish at least a second communication channel and/or another backup mode (paragraph 101-104, 120-131), and if so, opening communication on said second channel and/or according to said other mode, and the data are backed up via said second communication channel and/or said other mode (paragraph 101-104, 120-131; communication with remote backup center by means of various communication standards).

Regarding claim 6, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. SCHRIRE further discloses wherein the first channel is an SMS short message channel (paragraph 101-104).

Regarding claim 9, SCHRIRE discloses a portable device [1a-1c] comprising an application for backing up personal data of a subscriber of a wireless communication network by means of a first communication channel and according to a first backup mode (abstract), wherein the application can implement the following steps, comprising: determining whether the device has a function and/or another backup mode that allows it to establish at least a second communication channel and/or another backup mode (paragraph 101-104, 120-131), and if so, opening the communication on said second channel and/or said other mode, and proceeding to back up the data via said second communication channel and/or said other mode (paragraph 101-104, 120-131; communication with remote backup center by means of various communication standards).

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Regarding claim 10, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. SCHRIRE further discloses wherein said device comprises a subscriber identity module card (abstract).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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7. Claims 2 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over SCHRIRE et al (US 2004/0235523) in view of GOLDTHWAITE et al (US 2004/0176134 A1).

Regarding claim 2, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, SCHRIRE does expressly disclose wherein the function that makes it possible to establish at least a second communication channel is Bearer Independent Protocol (BIP). In the same field of the endeavor, GOLDTHWAITE discloses wherein a function that makes it possible to establish a communication channel is Bearer Independent Protocol (BIP) (abstract; paragraph 1, 3, 14-16). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify SCHRIRE to include the teachings of GOLDTHWAITE, since the use of Bearer Independent Protocol is a conventional and standardized protocol when remotely transferring data using SIM application toolkit.

Regarding claim 15, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. SCHRIRE further discloses wherein the first channel is an SMS short message channel (paragraph 101-104).

8. Claims 3, 4, 11, 16, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over SCHRIRE et al (US 2004/0235523) in view of EBERLE et al (US 7,061,929 B1).

Regarding claim 3, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, SCHRIRE does not expressly disclose

further comprising a prior step of detecting that the volume of the data to be backed up is larger than a predetermined volume, and selecting the second channel and/or another better adapted mode. In a similar field of endeavor, EBERLE discloses comprising a step of detecting that a volume of data to be backed up is larger than a predetermined volume, and selecting the second channel and/or another better adapted mode (col. 5, line 28-52; col. 6, line 27-46). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify SCHRIRE to include the teachings of EBERLE, since such a modification would allow a system to provide efficient transportation of data based on a determined need.

Regarding claim 4, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, the combination of SCHRIRE does not expressly disclose wherein the predetermined volume is equal to 200 Kbytes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a predetermined volume equal to 200 Kbytes, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claim 11, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, SCHRIRE does not expressly disclose further comprising a prior step of detecting that the volume of the data to be backed up is larger than a predetermined volume, and selecting the second channel and/or another better adapted mode. In a similar field of endeavor, EBERLE discloses comprising a step of detecting that a volume of data to be backed up is larger than a

predetermined volume, and selecting the second channel and/or another better adapted mode (col. 5, line 28-52; col. 6, line 27-46). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify SCHRIRE to include the teachings of EBERLE, since such a modification would allow a system to provide efficient transportation of data based on a determined need.

Regarding claim 16, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. SCHRIRE further discloses wherein the first channel is an SMS short message channel (paragraph 101-104).

Regarding claim 17, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. SCHRIRE further discloses wherein the first channel is an SMS short message channel (paragraph 101-104).

9. Claims 5 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over SCHRIRE et al (US 2004/0235523) in view of LARUE et al (US 6,810,405 B1).

Regarding claim 5, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, SCHRIRE does not expressly disclose wherein the second channel is chosen from among CSD, GPRS and WLAN. In the same field of endeavor, LARUE discloses wherein a channel is chosen from among CSD, GPRS and WLAN (col. 6, line 26-55). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify SCHRIRE to include the teachings of LARUE, since the use of standardized protocol when using wireless connections between a device and a network would have been an

obvious design choice since the system would perform equally well with known wireless communication technologies.

Regarding claim 18, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. SCHIRE further discloses wherein the first channel is an SMS short message channel (paragraph 101-104).

10. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over SCHIRE et al (US 2004/0235523) in view of REECE et al (US 5,915,214).

Regarding claim 7, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, SCHIRE does not expressly disclose including a prior assessment step, of determining whether the cost of the data to be backed up is higher than a predetermined threshold, and performing the backup according to the best adapted channel and/or backup mode. REECE discloses including a prior assessment step, of determining whether a cost of data to be backed up is higher than a predetermined threshold, and performing the backup according to the best adapted channel and/or backup mode (col. 13, line 4-31). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify SCHIRE to include the teachings of REECE, since such a modification would allow system selection based on a user defined cost threshold.

Regarding claim 8, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, SCHIRE does not expressly disclose including a prior assessment step of determining whether the cost of the data to be backed up is higher than a predetermined threshold, and performing the backup

according to an adapted channel and/or backup mode. REECE discloses including a prior assessment step of determining whether the cost of the data to be backed up is higher than a predetermined threshold, and performing the backup according to an adapted channel and/or backup mode col. 13, line 4-31). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify SCHRIRE to include the teachings of REECE, since such a modification would allow system selection based on a user defined cost threshold.

11. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over SCHRIRE et al (US 2004/0235523) in view of GOLDTHWAITE et al (US 2004/0176134 A1) and further in view of LARUE et al (US 6,810,405 B1).

Regarding claim 12, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, the combination of SCHRIRE and GOLDTHWAITE does not expressly disclose wherein the second channel is chosen from among CSD, GPRS and WLAN. In the same field of endeavor, LARUE discloses wherein a channel is chosen from among CSD, GPRS and WLAN (col. 6, line 26-55). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of SCHRIRE and GOLDTHWAITE to include the teachings of LARUE, since the use of standardized protocol when using wireless connections between a device and a network would have been an obvious design choice since the system would perform equally well with known wireless communication technologies.

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12. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over SCHRIRE et al (US 2004/0235523) in view of EBERLE et al (US 7,061,929 B1) and further in view of LARUE et al (US 6,810,405 B1).

Regarding claim 13 and 14, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, the combination of SCHRIRE and EBERLE does not expressly disclose wherein the second channel is chosen from among CSD, GPRS and WLAN. In the same field of endeavor, LARUE discloses wherein a channel is chosen from among CSD, GPRS and WLAN (col. 6, line 26-55). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of SCHRIRE and EBERLE to include the teachings of LARUE, since the use of standardized protocol when using wireless connections between a device and a network would have been an obvious design choice since the system would perform equally well with known wireless communication technologies.

13. Claim 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over SCHRIRE et al (US 2004/0235523) in view of GOLDTHWAITE et al (US 2004/0176134 A1) and further in view of REECE et al (US 5,915,214).

Regarding claim 19, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, the combination of SCHRIRE and GOLDTHWAITE does not expressly disclose including a prior assessment step, of determining whether the cost of the data to be backed up is higher than a predetermined threshold, and performing the backup according to the best adapted

channel and/or backup mode. REECE discloses including a prior assessment step, of determining whether a cost of data to be backed up is higher than a predetermined threshold, and performing the backup according to the best adapted channel and/or backup mode (col. 13, line 4-31). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of SCHRIRE and GOLDTHWAITE to include the teachings of REECE, since such a modification would allow system selection based on a user defined cost threshold.

14. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over SCHRIRE et al (US 2004/0235523) in view of EBERLE et al (US 7,061,929 B1) and further in view of REECE et al (US 5,915,214).

Regarding claim 20, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, the combination of SCHRIRE and EBERLE does not expressly disclose including a prior assessment step, of determining whether the cost of the data to be backed up is higher than a predetermined threshold, and performing the backup according to the best adapted channel and/or backup mode. REECE discloses including a prior assessment step, of determining whether a cost of data to be backed up is higher than a predetermined threshold, and performing the backup according to the best adapted channel and/or backup mode (col. 13, line 4-31). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of SCHRIRE and EBERLE to include the teachings of REECE, since such a modification would allow system selection based on a user defined cost threshold.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

AOYAMA (2002/0160760) – Backup of data of cellular phone

FLANAGIN (US 2002/0147836) – ROUTING notifications

DUTTA et al (US 2002/0156921 A1) – Automatic backup of wireless device

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ARIEL BALAOING whose telephone number is (571)272-7317. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571) 272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/William Trost/
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